

**REMARKS**

**I. Claim Status**

Claims 1-6 and 10 are currently pending. No claim amendments have been made herein.

**II. Information Disclosure Statement**

Applicants note that the Examiner failed to consider two documents listed on the Information Disclosure Statement PTO Form SB/08 that was submitted on May 23, 2007. See References Considered by the Examiner dated June 28, 2007. Those documents are Sipido, K.R. et al., "Altered Na/Ca exchange activity in cardiac hypertrophy and heart failure: a new target for therapy?" *Cardiovascular Research* (2002) 53:782-805, and Sipido, K.R. et al., Sodium Calcium Exchange as a Target for Antiarrhythmic Therapy," *Handbook of Experimental Pharmacology*, NY: Springer-Verlag (2006) 171:159-199. Furthermore, the Examiner has provided no explanation why those documents were not considered. Applicants respectfully request that the Examiner consider those references. For the Examiner's convenience, Applicants submit herewith an Information Disclosure Statement listing those documents. Applicants respectfully request that the Examiner consider those documents and indicate that she has done so by initialing the form.

**III. 35 U.S.C. § 103 Rejection**

The Examiner rejects claims 1-3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 2003/006452 to Koskelainen et al. ("Koskelainen"). Office Action at 2. Applicants respectfully traverse this rejection for at least the reason that follows.

The Examiner's reliance on Koskelainen as prior art is misplaced. For art to be relied upon under 35 U.S.C. § 103 as the basis for an obviousness rejection, the art

must first qualify as prior art under the definition of 35 U.S.C. § 102. Here, while Koskelainen qualifies as § 102(e) prior art<sup>1</sup>, it is not available as prior art for an obviousness rejection under 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) is disqualified as prior art against the claimed invention if that "subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. See M.P.E.P. § 706.02(I)(2)(II).

With this in mind, Applicants submit that Koskelainen is not available as prior art because the present invention and Koskelainen were, at the time the invention was made, subject to an obligation of assignment to the same person, i.e., Orion Corporation. See M.P.E.P. § 706.02(I)(2)(II).

Because Koskelainen is not prior art to the instant application, Applicants respectfully submit that the Examiner cannot rely upon it to support the pending § 103 rejection. For at least that reason, the rejection should be withdrawn.

Consequently, the Examiner's objection to claims 4-6 and 10 as depending from rejected base claims (Office Action at 3) should likewise be rendered moot in view of the arguments herein.

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<sup>1</sup> Applicants assert that the international application of Koskelainen published as WO 2003/006452 on January 23, 2003, does not qualify as prior art under 35 U.S.C. § 102(a) because of Applicants' January 9, 2003, priority date.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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